

REMARKS

Claims 1-10 and 12 are pending in this application. Reconsideration of the present application in view of the following remarks is respectfully requested.

Claims 1-10 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,088,777 ("Sorber") in view of U.S. Patent No. 6,192,457 ("Porterfield") in view of U.S. Patent No. 6,141,756 ("Bright"). Applicants respectfully submit that claims 1-10 and 12 are not rendered obvious by Sorber, Porterfield and Bright, for at least the reasons set forth below.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The prior art must suggest combining the features in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296; In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Independent claim 1 recites, in relevant parts, "providing a **first memory block in the memory device**; storing a **startup program in the first memory block**; providing additional memory blocks; and **connecting the first memory block and the additional memory blocks by a chained list**; wherein the memory device is checked before the chained list is executed and the **startup program obtains data for a check from the additional memory blocks**." Independent claims 6, 8 and 12 recite substantially similar

features as the above-recited features of claim 1. In support of the rejection, the Examiner contends that Sorber discloses the claimed features of “storing a **startup program** in the first memory block [of the memory device] (col. 7, par. 2)” and “connecting the first memory block and the additional memory blocks by a chained list (col. 16, lines 54-57).” However, Sorber explicitly indicates that the startup program is contained in the program memory 20 which is separate from the data memory 22, (see, e.g., col. 7, l. 1-14), and col. 16, l. 54-57 is merely a part of claim 34 which indicates that “each available memory block is linked to a next, available memory block in the same class and a first available memory block in the same class is indicated by a pointer,” which statement provides no context regarding which specific memory blocks are being referenced. In any case, “each available memory block” clearly cannot refer to the memory block containing the startup program; instead, “each available memory block is linked to a next, available memory block in the same class and a first available memory block in the same class is indicated by a pointer” recited in claim 34 of Sorber refers to the description in col. 8, l. 55-61, i.e., “If the memory block is a part of a message, it may be linked to other blocks in a list, (i.e., string of linked blocks), before the pointer to the first block in the message string is given to the next process. The memory manager 26 moves the class 1 available memory block pointer to the next memory block in that class.” Accordingly, the cited statement of Sorber that “each available memory block is linked to a next, available memory block in the same class and a first available memory block in the same class is indicated by a pointer” has absolutely nothing to do with linking of the memory block containing the startup program, and there is absolutely no teaching or suggestion in Sorber that the memory block containing the startup program (which is clearly in program memory 20) is connected to additional memory blocks by a chained list, let alone connected to the “available memory block” recited in col. 16, l. 54-57.

Independent of the above, regarding the feature that “the **memory device is checked** before the chained list is executed and the **startup program obtains data for a check** from the **additional memory blocks**,” the Examiner contends that “Porterfield discloses the startup program obtains data for a check from the additional memory blocks (col. 4, lines 3-13) to initialize the computer system upon being turned on (col. 4, lines 11-13).” However, col. 4, lines 3-13 of Porterfield has nothing to do with the startup program obtaining data for a check of the memory device, which data are obtained from the additional memory blocks; instead, this cited section of Porterfield merely discloses a system allocation table specifying system addresses for the various components of the computer

system, and that the “addresses allocated for each computer device in the system address allocation table typically will be set by the Basic Input-Output System (BIOS) software when the computer system 50 is initialized upon being turned ON.” Accordingly, col. 4, lines 3-13 of Porterfield has nothing to do with a check of the memory device, let alone anything to do with the startup program obtaining (from the additional memory blocks) data for a check of the memory device.

Independent of the above, regarding the feature that “**the memory device [containing the startup program and the additional memory blocks] is checked before the chained list is executed,**” the Examiner contends that Bright discloses this feature in col. 3, l. 15-27. However, in contrast to the Examiner’s contention, there is absolutely no suggestion in Bright regarding any memory device containing the startup program and the additional memory blocks is checked, let alone that any such memory device is checked before any chained list is executed; instead, the cited section of Bright merely indicates use of encryption/decryption in downloading a program from an external device 103 by a separate processor 101.

Not only do the overall teachings of Sorber, Porterfield and Bright fail to suggest all of the features of independent claims 1, 6, 8 and 12, but there is no logical reason why any person of ordinary skill in the art would be motivated to make the modifications asserted by the Examiner, particularly when one considers the completely different technologies involved in the applied references. For example, the teachings of Bright involve the use of encryption/decryption in downloading a program from an external device 103 by a separate processor 101, while the teachings of Porterfield involve implementing a graphics address remapping table as a virtual register in system memory, and the teachings of Sorber involve a memory management scheme for dynamic memory allocation corresponding to various data sizes. There is simply no logical reason why one of ordinary skill in the art would look to these completely unrelated teachings of Sorber, Porterfield and Bright, let alone any reason why one of ordinary skill in the art would specifically combine the selected teachings of these applied reference in the manner asserted by the Examiner.

For at least the foregoing reasons, the overall teachings of Sorber, Porterfield and Bright cannot possibly render independent claims 1, 6, 8 and 12, as well as their dependent claims 2-5, 7, 9 and 10, obvious.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

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